REMARKS

This responds to the Office Action mailed on <u>May 3, 2007</u>.

Claims 10, 21-22, 27, 33, 38, 63, and 260 are amended, claims 25, 28-29, 31-32, 34-37, 58-59, 61-62, 64-67, 246-253 are currently canceled, claims 1-9, 12, 26, 30, 40, 44, 56, 60, 68-245, 254-259 and 264-357 were previously canceled, and no claims are added; as a result, claims 10-11, 13-24, 27, 33, 38-39, 41-43, 45-55, 57, 63, 260-262 are now pending in this application.

§251 Rejection of the Claims

Claims 10-11, 13-25, 27-29, 31-39, 41-43, 45-55, 57-59, 61-67, 246-253, 260-263 were rejected under 35 U.S.C. § 251 as being based upon new matter. A rejection under 35 U.S.C. §251 is appropriate "If new subject matter is added to the disclosure, whether it be in the abstract, the specification, or the drawings," as stated in MPEP 2163.06. It is submitted that no new matter was introduced in the abstract, the specification, or the drawings and therefore the rejection under 35 U.S.C. § 251 is not proper. It is respectfully requested that the rejection be withdrawn.

§112 Rejection of the Claims

Claims 10,11,13-25,27-29,31-39,41-43,45-55,57-59,61-67,246-253,260-263 were rejected under 35 U.S.C. § 112 as omitting essential elements/critical features because they do not recite information stored in a permanent memory in the client computer. Each of the remaining independent claims, claims 10, 38, and 260, have been amended to recite "personal information of the user previously stored in the permanent memory in the client." It is submitted that the rejection have been overcome and it is respectfully requested that the rejection be withdrawn

Claims 10, 12, 15-16, 21-25, 28, 33-36, 38, 40, 43, 50-54, 58, 60, 63-66, 260, and 262-263 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Florin et al. (U.S. 5,621,456) in view of Schlafly (U.S. 4,734,858).

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111   Page 7
Serial Number: 09/672,523   Dkt: 2050.001US3
Filing Date: September 27, 2000
Title: METHOD AND SYSTEM TO FACILITATE ORDERING OF AN ITEM

§103 Rejection of the Claims

Claims 10, 12, 15-16, 21-25, 28, 33-36, 38, 40, 43, 50-54, 58, 60, 63-66, 260, and 262-263 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Florin et al. (U.S. 5,621,456) in view of Schlafly (U.S. 4,734,858).

The Office action correctly states that Florin fails to disclose or suggest enabling the user to place an order for the item by a single action. The Office action cites Schlafly to show this feature.

Schlafly discloses a pocket size data terminal that is used by the consumer to initially select and store data representative of the orders. (Schlafly, Abstract.) When later connected to a phone line the terminal can be commanded to automatically dial and transmit the stored data in a short burst over a telephone link to a local processing center for processing including customer verification, data format and credit verification, order placement and supplier contact. Each terminal is assigned an internal identification number and a specific local processing center which the terminal can automatically access. (Schlafly, 1: 44-57.) As explained above, the consumer must to initially select and store data representative of the orders. Specifically, Schlafly discloses an ORDER key to store the order data collected from the customerin the send memory. (Schlafly, 9: 12-21.) In order to actually send the order, Schlaflin utilizes a send instruction implemented by the ENTER key. (Schlafly, 10: 3-10.) While Schlafly discloses sending the order data to an appropriate destination by actuating the ENTER key, it takes more than a single action on the part of a user to select an item, enter the order-related information, such as the quantity and the supplier (Schlafly, 7: 26-34), save the order data and, finally, transmit the order.

In contrast, claim 10, as amended, recites "receiving a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data" and "responding to the single action by ... retrieving personal information of the user from a permanent memory in the client, combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and transmitting the order for the item from the client." Because, Schlafly, whether considered separately or in combination with Florin, does not disclose or suggest responding to a single action by a user by performing

operations that together make it possible to place an order (specifically, a combination of "retrieving personal information of the user from a permanent memory in the client, combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and transmitting the order for the item from the client," as recited in claim 10 as amended), claim 10 and its dependent claims are patentable in view of the Schlafly and Florin combination and should be allowed.

Claim 38, as amended, recites "an event detector to detect a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data" and "an event processing module to respond to the single action by ... retrieving personal information of the user from a permanent memory in the client, combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and transmitting the order for the item from the client." Because, as discussed above with reference to claim 10, Schlafly, whether considered separately or in combination with Florin, does not disclose or suggest these features, claim 38 and its dependent claims are patentable in view of the Schlafly and Florin combination and should be allowed at least for the reasons articulated with respect to claim 10.

Claim 260, as amended, recites "an event detector to detect a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data" and "an event processing module to respond to the single action by ... retrieving personal information of the user from a permanent memory in the client, combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and transmitting the order for the item from the client." Because, as discussed above with reference to claim 10, Schlafly, whether considered separately or in combination with Florin, does not disclose or suggest these features, claim 260 is patentable in view of the Schlafly and Florin combination and should be allowed at least for the reasons articulated with respect to claim 10.

Claims 11, 29, 39 and 59 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Florin et al. and Schlafly as applied to claims 10, 28, 38 and 58 above, and further in view

of Zachary et al. ("Technology: HP is building Gadget to Make TVS Interactive"). Claims 11 and

Claim 11 recites "receiving a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data" and "responding to the single action by ... retrieving personal information of the user from a permanent memory in the client, combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and transmitting the order for the item from the client," by virtue of its being dependent on claim 10 As discussed above with reference to claim 10, Schlafly, whether considered separately or in combination with Florin, does not disclose or suggest these features. Zachary is directed at shopping on the interactive TV system (Zachary, Abstract) and also fails to disclose or suggest these features, whether considered separately or in combination with Florin and Schlafly. Thus, claim 11 is patentable in view of the Schlafly, Florin, and Zachary combination and should be allowed.

Claim 39 recites "an event detector to detect a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data" and "an event processing module to respond to the single action by ... retrieving personal information of the user from a permanent memory in the client, combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and transmitting the order for the item from the client," by virtue of its being dependent on claim 38 As discussed above with reference to claim 38, Schlafly, whether considered separately or in combination with Florin, does not disclose or suggest these features. As stated above, Zachary also fails to disclose or suggest these features, whether considered separately or in combination with Florin and Schlafly. Thus, claim 39 is patentable in view of the Schlafly, Florin, and Zachary combination and should be allowed.

Claims 29 and 59 were cancelled.

Claims 13-14, 17, 31-32, 41-42, 45 and 61-62 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Florin et al. and Schlafly in view of Pires (U.S. 4,163,255).

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111
Serial Number: 09/672,523
Filing Date: September 27, 2000
Title: METHOD AND SYSTEM TO FACILITATE ORDERING OF AN ITEM

Page 10
Dkt: 2050.001US3

Claims 3-14, and 17 recite "receiving a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data" and "responding to the single action by ... retrieving personal information of the user from a permanent memory in the client, combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and transmitting the order for the item from the client," by virtue of their being dependent on claim 10. As discussed above with reference to claim 10, Schlafly, whether considered separately or in combination with Florin, does not disclose or suggest these features. Pires is directed at a billing method for a subscriber of a pay television system (Pires, Abstract) and also fails to disclose or suggest these features, whether considered separately or in combination with Florin and Schlafly. Thus, claims 3-14, and 17 are patentable in view of the Schlafly, Florin, and Pires combination and should be allowed.

Claims 41-42, and 45 recite "an event detector to detect a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data" and "an event processing module to respond to the single action by ... retrieving personal information of the user from a permanent memory in the client, combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and transmitting the order for the item from the client," by virtue of their being dependent on claim 38. As discussed above with reference to claim 38, Schlafly, whether considered separately or in combination with Florin, does not disclose or suggest these features. As stated above, Pires also fails to disclose or suggest these features, whether considered separately or in combination with Florin and Schlafly. Thus, claims 41-42, and 45 are patentable in view of the Schlafly, Florin, and Pires combination and should be allowed.

Claims 31-32 and 61-62 were cancelled.

Claims 27, 37, 54-55, 57, 67 and 246-253 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Florin et al. and Schlafly in view of Harvey et al. (U.S. 4,965,825).

Claim 27 recites "receiving a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data" and "responding

to the single action by ... retrieving personal information of the user from a permanent memory in the client, combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and transmitting the order for the item from the client," by virtue of their being dependent on claim 10. As discussed above with reference to claim 10, Schlafly, whether considered separately or in combination with Florin, does not disclose or suggest these features. Harvey discloses unified system of programming communication for use on individual computer systems with capacity for generating relevant user specific information simultaneously at each station of a plurality of subscriber stations (Harvey, Abstract) and also fails to disclose or suggest these features, whether considered separately or in combination with Florin and Schlafly. Thus, claim 27 is patentable in view of the Schlafly, Florin, and Harvey combination and should be allowed.

Claims 54-55 and 57 recite "an event detector to detect a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data" and "an event processing module to respond to the single action by ... retrieving personal information of the user from a permanent memory in the client, combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and transmitting the order for the item from the client," by virtue of their being dependent on claim 38. As discussed above with reference to claim 38, Schlafly, whether considered separately or in combination with Florin, does not disclose or suggest these features. Harvey discloses unified system of programming communication for use on individual computer systems with capacity for generating relevant user specific information simultaneously at each station of a plurality of subscriber stations (Harvey, Abstract) and also fails to disclose or suggest these features, whether considered separately or in combination with Florin and Schlafly. Thus, claims 54-55 and 57 are patentable in view of the Schlafly, Florin, and Harvey combination and should be allowed.

Claims 37, 67, and 246-253 were cancelled.

Claim 261 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Florin et al. and Schlafly as applied to claim 260 above, and further in view of Harvey et al. Claim 261 was cancelled.

Claims 18-20 and 46-48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Florin et al. and Schlafly as applied to claims 10 and 38 above, and further in view of Mustafa et al. (U.S. 4,789,895).

Claims 18-20 recite "receiving a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data" and "responding to the single action by ... retrieving personal information of the user from a permanent memory in the client, combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and transmitting the order for the item from the client," by virtue of their being dependent on claim 10. As discussed above with reference to claim 10, Schlafly, whether considered separately or in combination with Florin, does not disclose or suggest these features. Mustafa is directed at a telecommunication system for synchronizing a digital bit stream sent from a central facility to a terminal on lines of television frames (Mustafa, Abstract) and also fails to disclose or suggest these features, whether considered separately or in combination with Florin and Schlafly. Thus, claims 18-20 are patentable in view of the Schlafly, Florin, and Mustafa combination and should be allowed.

Claims 46-48 recite "an event detector to detect a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data" and "an event processing module to respond to the single action by ... retrieving personal information of the user from a permanent memory in the client, combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and transmitting the order for the item from the client," by virtue of their being dependent on claim 38. As discussed above with reference to claim 38, Schlafly, whether considered separately or in combination with Florin, does not disclose or suggest these features. As stated above, Mustafa also fails to disclose or suggest these features, whether considered separately or in combination with Florin and Schlafly. Thus, claims 46-48 are patentable in view of the Schlafly, Florin, and Mustafa combination and should be allowed.

RESERVATION OF RIGHTS

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 408-278-4052 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

KURIACOSE JOSEPH ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
408-278-4052

Date _____August 3, 2007_____ By ___/Elena Dreszer/_____
　　　　　　　　　　　　　　　　　　　　　Elena B. Dreszer
　　　　　　　　　　　　　　　　　　　　　Reg. No. 55,128

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this __3__ day of August 2007.

_____　　　　　　_____
Name　　　　　　　　　　　　　　　　　　　　　Signature